

REMARKS

Claims 21-39 are pending in the instant application. Applicants acknowledge the Examiner's indication that claims 25-28, 31, 32, 35-38 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. By this amendment, claims 23-24 and 31-39 have been canceled without prejudice. Applicants reserve the right to pursue the subject matter of the canceled claims in this application or other related applications. Claims 21, 22, 29, and 30 have been amended. Claim 22 have been amended to include the recitation of an alternative amino acid sequence of human gro-1 which is disclosed in Figure 9A and 9B of the specification as filed and assigned the sequence identifier SEQ ID NO: 63 as of the amendment to the specification and substitute sequence listing filed on December 4, 2003. No new matter is added.

1. THE REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, FOR LACK OF WRITTEN DESCRIPTION IS OBIATED

Claims 23, 24, and 31-39 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Without acquiescing to the Examiner's reasons for rejecting the claims, and in the sole interest of expediting prosecution of the present application, claims 23, 24, and 31-39 have been canceled without prejudice.

In view of the foregoing, the rejection is obviated.

2. THE REJECTIONS UNDER 35 U.S.C. § 102(B) FOR ANTICIPATION SHOULD BE WITHDRAWN

Claim 22 is rejected under 35 U.S.C. § 102(b) as being anticipated by Hudson ("Hudson", Accession number G24438, May 31, 1996). Hudson et al. discloses human STS WI-12773 which is a complement to residues 1778-2029 of SEQ ID NO:3. The Examiner

alleges that claim 22 is drawn in part to the complement of said polynucleotide and does not specify the extent of the complementary region.

In response, claim 22 has been amended to recite the term “complete” in reference to the complement of the claimed polynucleotide. As such, the polynucleotide of amended claim 22 and its complete complement are not identical to Hudson which only discloses a complement of residues 1778-2029 of SEQ ID NO: 3.

Claims 21 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by BioLabs Catalog (1993-1994, page 91) which discloses random hexamers that are complementary to the claimed polynucleotides.

In response, claim 21 has also been amended to recite the term “complete” in reference to the complement of the claimed polynucleotide. Likewise, the claimed polynucleotides of claims 21 and 22 and their complete complements are not identical to the random hexamers disclosed in the Biolabs Catalog.

Anticipation under 35 U.S.C. § 102 requires identity of invention. The court made it absolutely clear that "anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference ... [and] ... [t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person or ordinary skill in the field of the invention." *Scripps Clinic & Research Fdn. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

In view of the foregoing, the rejections under 35 U.S.C. § 102(b) should be withdrawn.

3. THE REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, FOR LACK OF ENABLEMENT SHOULD BE WITHDRAWN

Claims 29, 30, 33, 34, and 39 are rejected under 35 U.S.C. § 112, first paragraph, because the specification while being enabling for isolated host cells comprising vectors, does not reasonably provide enablement for cells comprised within a transgenic animal, or an animal having been treated by gene therapy.

Without acquiescing to the Examiner's reasons for rejecting the claims, and in the sole interest of expediting prosecution of the present application, claims 29 and 30 have been amended to recite the term "isolated" in reference to the host cells. As indicated by the Examiner in the Office Action, "isolated host cells comprising vectors" are enabled. Applicants submit that the amended claims 29 and 30 meet the enablement requirements of 35 U.S.C. § 112, first paragraph.

In view of the foregoing, the rejection is obviated.

CONCLUSION

Applicants respectfully request that the foregoing amendments and remarks be made of record in the file history of the instant application. In light of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at 212-326-3939, if a telephone call could help resolve any remaining items.

Respectfully submitted,

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